

REMARKS

The indication that claims 12-21 and 23 include patentable subject matter is acknowledged with thanks.

Claims 1-23 were rejected under §112, second paragraph, and have been amended solely as to form bearing in mind the criticisms in the Official Action. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-2, 10 and 22 were rejected as unpatentable over NARUSE JP 58212749 in view of ZEMEL et al. 4,906,482.

The Official Action states that NARUSE discloses (conventional) ice cream made with potato puree, and acknowledges that this reference does not disclose the use of soybean in the ice cream. The Official Action relies on ZEMEL et al. for the suggestion to substitute soymilk in the ice cream of NARUSE.

ZEMEL et al. disclose a method of fortifying soymilk with calcium. They add an alkali metal polyphosphate salt to the soymilk and then add human consumable calcium. Further, ZEMEL et al. discuss that a significant problem of soymilk is the soy odor, and they indicate that the additives added to the soymilk desirably are either tasteless or aid in imparting a pleasant taste and odor to the soymilk (column 2, lines 13-15). If ZEMEL et al. is to be relied upon, then it must be relied upon for what it teaches in its entirety, without picking and choosing parts

thereof in accordance with what is only taught by the applicant herein. The additives suggested by ZEMEL et al. cannot be ignored because they make the soymilk palatable and add calcium.

However, there is no indication in either reference how the potatoes in the NARUSE ice cream would react with the alkali metal polyphosphate salt and human consumable calcium added by ZEMEL et al. One of skill in the art would have no reasonable expectation that the combination would be successful. The fact that the references can be combined or that the claimed invention is within the skill of one of ordinary skill in the art is not sufficient to establish *prima facie* obviousness; a reasonable expectation of success is required (MPEP §2143).

The effect of the alkali metal polyphosphate salt and human consumable calcium in ZEMEL et al. on the potatoes in NARUSE is unknown from these references and one of skill in the art would not make a human food product without knowing how the combination would react. The potatoes in NARUSE could have a detrimental effect on the action of the alkali metal polyphosphate salt and human consumable calcium in the soymilk of ZEMEL et al., or the alkali metal polyphosphate salt and human consumable calcium in the soymilk of ZEMEL et al. could change the palatability of the potato ice cream in NARUSE. There is nothing in the references to indicate to one of skill in the art

that the combination proposed in the Official Action would make a safe and palatable food product and thus there is no basis for asserting that there is a reasonable expectation of success.

Further, one of the features of the potatoes in the soymilk ice cream of the present invention is the spontaneous emulsifying action due to the starch (page 5, last full paragraph), and the salt and calcium could change the emulsifying effect of the potatoes if the teachings of ZEMEL et al. were followed.

Accordingly, it is not believed that one of skill in the art would make the combination suggested in the Official Action. Reconsideration and withdrawal of this rejection under §103 are respectfully requested.

Claim 3 was rejected as unpatentable further in view of JP 61-96953 and SERPELLONI et al. 4,675,200. Claim 3 provides that the potato is a sweet potato. JP '953 suggests coating an ice cream with a sweet potato paste. However, the reference does not disclose or suggest that the ice cream actually "comprises" the sweet potato paste. By way of analogy, vanilla ice cream coated with a chocolate shell is not chocolate ice cream, and thus ice cream coated with a sweet potato paste is not sweet potato ice cream. Accordingly, reconsideration and withdrawal of this rejection of claim 3 are respectfully requested.

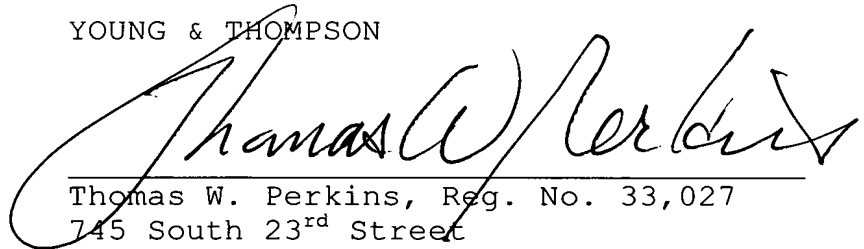
Claims 4-9 and 11 were rejected in view of further references. These claims are allowable for the reasons set forth above.

In view of the present amendment and the foregoing remarks, it is believed that the present application has been placed in condition for allowance. Reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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